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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,868	12/29/2003	Richard John Newson	0074-497816	2831
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EXAMINER				
ROBERTS, LEZAH				
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09/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/747,868

Applicant(s)

NEWSON, RICHARD JOHN

Examiner

LEZAH W. ROBERTS

Art Unit

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 21-41 is/are pending in the application.
- 4a) Of the above claim(s) 13,23 and 37-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-18, 21,22 and 24-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in Response to the Amendment filed May 16, 2008. All previous rejections have been withdrawn unless indicated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims

Claim Rejections - 35 USC § 102 – Anticipation (Previous Rejection)

1) Claims 1-4, 6, 8, 14, 20-21, 24, 25-27, 29 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson (US 5,297,730). The rejection is maintained in regards to claims 1-4, 6, 8, 14, 21, 24, 25-27, 29 and 35. Claim 20 has been cancelled.

Applicant's Arguments

Applicant argues Thompson preheats an herbicidal liquid and then applies the heated liquid to the weeds or other vegetation, whereas in the instant invention, the weeds are heated and then a liquid herbicide or oil is applied to the weeds. This argument is not persuasive.

Examiner's Response

The reference discloses a second spray comprising minor quantities of chemically active ingredients may be sprayed following treatment with heated water (col. 2, lines 60-66). The chemicals include herbicides, oils, surfactants, insecticides and fertilizers (col. 7, lines 14-25). This meets the limitation of applying a liquid substance immediately after heat because the step of spraying with heated water encompasses the limitation of exposing the weeds to hot air containing water, which is recited in claim 3.

Claim Rejections - 35 USC § 103 – Obviousness – (Previous Rejections)

1) Claims 15 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (US 5,297,730) in view of Bartlett et al. (US 2,867,519). The rejection is maintained.

Applicant's Arguments

Applicant argues the claims require the step of exposing weeds to heat followed by a liquid, such as an herbicide or oil. Thompson discloses preheating the liquid and applying it to weeds. Even if the compositions of Bartlett et al. were used in the methods of Thompson, the resulting process would not be the same as the Applicant's claimed method as set forth in the instant claims.

Applicant further notes that Table 2 of the instant specification reports more effective results when using heat and an herbicide together than using the two separately. There is not disclosure or suggestion of such an effect in any of the

references cited by the Examiner. Applicant also asserts that the sequence of applying each component is important. This argument is not persuasive.

Examiner's Response

As disclosed in the Examiner's Response above, Thompson discloses heating the weeds with water followed by spraying the weeds with an herbicide or oil. Therefore when the herbicide of Bartlett is used in the method of Thompson, the resulting process encompasses that of the instant claims.

In regards to the results, the claims recited a method of administering heat followed by applying an herbicide, which is suggested by the primary reference. It would be reasonable for one of skill in the art to expect using heat with an herbicide would have a greater effect than using each alone because it would be expected that they would have an additive effect. Applicant has not shown that the results of the combination are of a significant level such that they are unexpected from the cited art. See MPEP 7.16.02, I. In regards to the sequence of applying the heat and herbicide, selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results. See MPEP 2144.04, IV. Furthermore Applicant does not appear to provide a showing that the order of application of each component is critical to the effectiveness of the reference.

2) Claims 9-12 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (US 5,297,730) in view of Innes (US 6,759,370). The rejection is maintained.

Applicant's Arguments

Applicant argues the claims require the step of exposing weeds to heat followed by a liquid, such as terpene-based herbicide. Thompson discloses preheating the liquid and applying it to weeds. Even if the compositions of Innes were used in the methods of Thompson, the resulting process would not be the same as the Applicant's claimed method as set forth in the instant claims. This argument is not persuasive.

Examiner's Response

As disclosed in the Examiner's Response above, Thompson discloses heating the weeds with water followed by spraying the weeds with an herbicide or oil. Therefore when the herbicide of Innes is used in the method of Thompson, the resulting process encompasses that of the instant claims.

In regards to Applicant's results and sequence of application of each component, see Examiner's response above.

Claim Rejections - 35 USC § 103—Obviousness (New Rejection)

1) Claims 1-8, 15-18, 21, 22, 24-30, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adey et al. (US 5,946,851) in view of Bartlett et al. (US 2,867,519).

Adey et al. disclose a method for killing weeds using hot air. The temperature for killing the weeds ranges from 100°C to 900°C (col. 2, lines 19-22). The hot air is added to the weeds in the presence of water. Alternatively water may be added to the foliage followed by heating with water. Following heating, a residual heat mass is present on the foliage. The heating means is a gas fire heating means, which encompasses a radiant heat source of claim 5. The hot water spray/air mixture may also contain steam if the water becomes heated sufficiently. A saline solution may be added to the water, steam or moisture. The rate of decay of the dead weeds over days or weeks subsequently may also be increased relative to hot air alone. The flow rate is at least 600 liters/minute. When using hoses, the rate for water is less than 1 liter/minute in a hot air stream of 100 liters/minute. The apparatus used by the operator is easier and more convenient to move about (col. 1, line 60 to col. 2, line 35). The reference differs from the instant claims insofar as it does not disclose an herbicide is applied to the weeds after heat.

Bartlett et al. disclose herbicidal grease compositions comprising a lithium soap of a hydrogenated fish oil fatty acid salt (see claim 6). The compositions are non-volatile, long-persistent floricial compositions (col. 2, lines 8-10). The compositions are highly resistant to rain water and the like and do not melt easily in the sun (col. 4, lines

4-5). The reference differs from the instant claims insofar as it does not disclose applying the herbicidal grease to weeds after their treatment with heat.

Generally, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. See MPEP 2144.05, I. It would have been obvious to one of ordinary skill in the art to have used the heating method of the primary reference with the herbicide of the secondary reference motivated by the desire to use two methods disclosed by the art to achieve the same goal of killing weeds and to more effectively kill weeds by using two different types of treatments, as supported by cited precedent.

It also would have been obvious to one of ordinary skill in the art to have applied the herbicidal compositions after the heating method of the primary reference motivated by the desire to treat the area with a herbicide that was durable in the sunlight and does not easily washed away by rain therefore providing prolonged treatment, as disclosed by the secondary reference.

In regards to claims 16 and 17, it is *prima facie* obviousness to select a known material based on its suitability for its intended use. See MPEP 2144.07. The rate of applying a liquid substance to kill weeds of 50 litres per hectare of surface area has been disclosed in the art¹. It would have been obvious to apply the liquid at this rate

¹ Bakos et al., US 5,008,440, col. 4, lines 1-18. This reference is used as a general teaching and is not relied upon as the basis for the rejection.

motivated by the desire to use an application rate disclosed as suitable for applying a liquid for killing weeds.

In regards to Applicant's results and sequence of application of each component, see Examiner's response above.

Claims 1-12, 14-18, 21, 22 and 24-36 are rejected.

Claims 13, 23 and 37-41 are withdrawn.

No claims allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEZAH W. ROBERTS whose telephone number is (571)272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lezah W Roberts/
Examiner, Art Unit 1612

/Frederick Krass/

Application/Control Number:
10/747,868
Art Unit: 1612

Page 10

Supervisory Patent Examiner, Art Unit 1612